



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,801	08/18/2003	Sanjay Bhanot	RTS-0678US	4755
56907 7590 05/23/2007 ELMORE PATENT LAW GROUP 209 MAIN STREET N. CHELMSFORD, MA 01863			EXAMINER ANGELL, JON E	
			ART UNIT 1635	PAPER NUMBER
			MAIL DATE 05/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/643,801	Applicant(s) BHANOT ET AL.	
	Examiner J. Eric Angell	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-18,22-40,44 and 49-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-9,11-17,22,44 and 58-60 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18, 23-40, 49-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in response to the amendment filed on 3/21/2007.

The amendment filed 3/21/2007 is acknowledged and has been entered.

Claims 1, 3-9, 11-18, 22-40, 44, 49-60 are currently pending in the application and are addressed herein.

1. Claims 1, 3-9, 11-17, 22, 44 and 58-60 are directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), claims 18, 23-40, 49-57, directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement as set forth in the Office action mailed on 5/27/2005 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

However, upon further consideration of rejoined process claims (claims 18, 23-40, 49-57, it was determined that these claims encompass a number of patentably distinct processes which are subject to restriction as set forth below.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 24 (including linking claims 23, 32), drawn to a method of ameliorating/lessening the severity of a cardiovascular disorder, classified in class 514, subclass 44.
 - II. Claims 25-27, 31 (including linking claims 23, 32), drawn to a method of ameliorating/lessening the severity of obesity, classified in class 514, subclass 44.
 - III. Claims 28 (including linking claims 23, 32), drawn to a method of ameliorating/lessening the severity of diabetes, classified in class 514, subclass 44.
 - IV. Claims 29 (including linking claims 23, 32), drawn to a method of ameliorating/lessening the severity of cholesterolemia, classified in class 514, subclass 44.
 - V. Claims 30 (including linking claims 23, 32), drawn to a method of ameliorating/lessening the severity of liver steatosis, classified in class 514, subclass 44.
 - VI. Claims 33, 52, drawn to a method of lowering serum free fatty acids as well as modulating fatty acid synthesis, classified in class 514, subclass 44.
 - VII. Claim 34, drawn to a method of lowering serum triglycerides, classified in class 514, subclass 44.

Art Unit: 1635

- VIII. Claim 35, drawn to a method of lowering HDL, classified in class 514, subclass 44.
- IX. Claim 36, drawn to a method of lowering total serum cholesterol, classified in class 514, subclass 44.
- X. Claims 37, 39, 40, drawn to a method of lowering plasma insulin, classified in class 514, subclass 44.
- XI. Claim 38, drawn to a method of lowering hepatic triglycerides, classified in class 514, subclass 44.
- XII. Claim 50 (including linking claims 18, 49), drawn to a method of inhibiting diacylglycerol acyltransferase 2 expression in a white adipose cell, classified in class 514, subclass 44.
- XIII. Claim 51 (including linking claims 18, 49), drawn to a method of inhibiting diacylglycerol acyltransferase 2 expression in a brown adipose cell, classified in class 514, subclass 44.
- XIV. Claim 53, drawn to a method of modulating lipogenesis, classified in class 514, subclass 44.
- XV. Claim 54, drawn to a method of modulating gluconeogenesis, classified in class 514, subclass 44.
- XVI. Claim 55-57, drawn to a method of liver weight, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1635

2. Claims 23, 32 link(s) the inventions of Groups I-V. Claims 18, 49 link(s) the inventions of Groups XII-XIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Inventions I-XVI are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a materially different design, mode of operation, function, or effect because each group encompasses a different condition or biological function and each condition/function constitutes a different function or effect. Additionally, each method has a different design or mode of operation because each method treats a different condition or addresses a different biological activity. That is, since cardiovascular disorders, obesity, diabetes, cholesterolemia, liver steatosis are distinct conditions

Art Unit: 1635

with different etiologies, methods of treating each condition represents a different design, mode of operation, function, or effect. Similarly, lowering serum free fatty acids, lowering serum triglycerides, Lowering HDL, lowering total serum cholesterol, lowering plasma insulin, lowering hepatic triglycerides, modulating lipogenesis, modulating gluconeogenesis, and reducing liver weight target specific and distinct biological activities, thus these methods have a different design, mode of operation, function, or effect. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1635

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is 571-272-0756. The examiner can normally be reached on Monday-Thursday 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. E. Angell/

Primary Examiner, AU 1635